REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-64 and 66-77 remain pending. Claims 1-64, 66, and 67 have been rejected.

Claims 1, 29, 33, 34, and 61 have been amended. No claims have been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicants submit that the amendments do not add new matter.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-29, 31-64, and 66-77 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,267,303 to Johnson, et al. ("Johnson") in view of U.S. Publication No. US2006/0126101 A1 to Shutt, et al. ("Shutt").

Amended claim 1 reads as follows:

> A computer-implemented method comprising:
> receiving an image of an overview of a collection that comprises a first plurality of indication areas associated with a third plurality of documents and a second plurality of indication areas associated with a fourth plurality of actions;
> <u>identifying at least one action from the fourth plurality of actions set forth in the image;</u>
> <u>identifying at least one document from the third plurality of documents, wherein the identifying the at least one action from the fourth plurality of actions set forth in the image is performed based on the second plurality of the indication areas in the image and the identifying the at least one document from the third plurality of documents is performed based on the first plurality of the indication areas in the image;</u> and
> <u>performing at least one action on the at least one document in response to the identifying the at least one action from the fourth plurality of actions set forth in the image and the identifying the at least one document from the third plurality of documents from the image.</u>

(Amended claim 1)(emphasis added)

It is respectfully submitted that Johnson does not teach or suggest a combination with Shutt, and Shutt does not teach or suggest a combination with Johnson. It would be impermissible hindsight, based on applicant's own disclosure, to combine Johnson and Shutt.

Johnson discloses using a form to request an automatic creation of another form with fields for requesting operations in relation to items. More specifically, Johnson discloses a form [550], (Figure 8) that is created in response to receiving form 500 in FIG. 7. In particular, Johnson discloses "The user can check the boxes in fields 600, 602, and 604 to request facsimile transmission of document A, document B, and document C, respectively" (col. 20, lines 17-21).

The Examiner acknowledged that "Johnson…does not …teach… identifying at least one document, wherein the identifying the at least one action is performed based on the second plurality of the indication areas in the image… and the identifying the at least one document is performed based on the first plurality of the indication areas in the image; and performing the at least one action on the at least one document in response to the identifying the at least one action and the at least one document from the image."(Office Action mailed 11/27/07, p. 7).

Shutt, in contrast, discloses a system and method for detecting interruptions that occur during the process of sending images of a set of source pages via fax and determining that two separate transmissions are associated with each other. More specifically, Shutt discloses:

> In addition to using barcodes sheets for identification of documents, the system enables the user to generate barcode sheets that instruct the system <u>to take a predefined action</u> associated with a folder and/or document in the repository. <u>For example, a user can generate a barcode sheet that instructs the system to send an email notification indicating</u> that a particular folder contains all documents necessary for the business transaction. This type of barcode sheet is referred to as an "action barcode sheet" and is typically included as the last page of a fax containing documents and coversheets. An example of such an action, shown in FIG. 6, is an e-mail notification that the folder is complete.

(Shutt, paragraph [0066])(emphasis added)

Thus, Shutt discloses a barcode sheet that instructs a system to take a predetermined action. In contrast, amended claim 1 refers to identifying at least one action from the fourth plurality of actions set forth in the image; identifying at least one document from the third plurality of documents, wherein the identifying the at least one action from the fourth plurality of actions set forth in the image is performed based on the second plurality of the indication areas in

the image and the identifying the at least one document from the third plurality of documents is performed based on the first plurality of the indication areas in the image; and performing the at least one action on the at least one document in response to the identifying the at least one action from the fourth plurality of actions set forth in the image and the identifying the at least one document from the third plurality of documents from the image.

Furthermore, even if a fax handling of Shutt were incorporated into a method of automatic creation of form of Johnson, such a combination would still lack identifying at least one action from the fourth plurality of actions set forth in the image; identifying at least one document from the third plurality of documents, wherein the identifying the at least one action from the fourth plurality of actions set forth in the image is performed based on the second plurality of the indication areas in the image and the identifying the at least one document from the third plurality of documents is performed based on the first plurality of the indication areas in the image; and performing the at least one action on the at least one document in response to the identifying the at least one action from the fourth plurality of actions set forth in the image and the identifying the at least one document from the third plurality of documents from the image, as recited in amended claim 1.

Therefore, applicant respectfully submits that claim 1, as amended, is not obvious under 35 U.S.C. § 103(a) over Johnson in view of Shutt.

Given that claims 2-29, 31-64, and 66-77 contain the limitations that are similar to those limitations discussed with respect to amended claim 1, applicant respectfully submit that claims 2-29, 31-64, and 66-77 are not obvious under 35 U.S.C. § 103(a) over Johnson in view of Shutt.

The Examiner has rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Shutt further in view of U.S. Patent No. 5,680,223 to Cooper, et al. ("Cooper").

Cooper, in contrast, discloses labeling a document for storage, manipulation, and retrieval, and similarly to Johnson, and Shutt, fails to disclose, teach, or suggest identifying at least one action from the fourth plurality of actions set forth in the image; identifying at least one document from the third plurality of documents, wherein the identifying the at least one action from the fourth plurality of actions set forth in the image is performed based on the second plurality of the indication areas in the image and the identifying the at least one document from the third plurality of documents is performed based on the first plurality of the indication areas in the image; and performing the at least one action on the at least one document in response to the identifying the at least one action from the fourth plurality of actions set forth in the image and the identifying the at least one document from the third plurality of documents from the image, as recited in amended claim 1.

Given that claim 30 depends from amended claim 1, and adds additional limitations, applicant respectfully submit that claim 30 is not obvious under 35 U.S.C. § 103(a) over Johnson, in view of Shutt, and further in view of Cooper.

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If there are any additional charges, please charge Deposit Account No. 022666 for any fee deficiency that may be due.

Respectfully submitted,

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